

REMARKS

Applicants hereby add new claims 29-33. Accordingly, claims 1-20 and 22-33 are pending in the present application.

Claim 23 stands rejected under 35 USC 112, second paragraph, for indefiniteness. Claims 1, 4, 6-8, 11-12, 14-15, 17, 19, and 21-28 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,108,099 to Ohtani in view of U.S. Patent No. 6,430,711 to Sekizawa. Claim 3 stands rejected under 35 USC 103(a) for obviousness over Ohtani and Sekizawa and further in view of U.S. Patent No. 6,272,472 to Danneels et al. Claims 2, 5, 9-10, 13, 16, 18, and 20 stand rejected under 35 USC 103(a) for obviousness over Ohtani and Sekizawa and further in view of U.S. Patent No. 6,625,581 to Perkowski.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the indefiniteness rejection of claim 23, without admitting to the propriety of the indefiniteness rejection, and in continued effort to further the prosecution of the present application, Applicants have amended claim 23. Claim 23 now recites limitations previously inherently present within claim 23 and accordingly the amendment to claim 23 does not narrow claim 23. Applicants respectfully request withdrawal of the indefiniteness rejection.

With reference to the obviousness rejections, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

As discussed further below, there is no motivation to combine the reference teachings, and even if combined, the combination fails to disclose or suggest positively recited limitations of the claims and the pending claims are allowable.

Referring to claim 1, it is stated on page 3 of the Action that Ohtani allegedly discloses the determining and programming steps. Applicants disagree for at least the following compelling reasons.

Initially, Applicants note that the Office presents contradictory statements

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with respect to the teachings of Ohtani. On page 4 of the Action, it is stated that Ohtani does not disclose the geographical area within which the engine is to be deployed. However, on page 3 of the Action it is stated that Ohtani allegedly disclosed determining an electronic address for a consumables supplier appropriate to a geographical area. Applicants submit that it is non-sensical to interpret a reference *which does not address the geographical area of deployment as teaching or suggesting determining an electronic address for a consumables supplier appropriate to the geographical area.*

Further, Applicants have electronically searched Ohtani and have failed to uncover any geographical teachings regarding deployment of a fax device. Ohtani at col. 2, lines 1-12 merely discloses storing an address of a network terminal devoid of any teachings with respect to deployment in a geographical area. The teachings of col. 5, lines 14-25 of Ohtani merely state that the fax may be programmed with the email address of the official responsible for the fax at 103 as well as the email address used to order paper at 106. Such teachings are devoid of any teachings that the email addresses determined at 103 or 106 are appropriate to a geographical area as claimed. Col. 6, lines 10-20 of Ohtani disclose that the addresses inputted at 103 and at 106 may be embedded within a generated email. The identified teachings fail to disclose or suggest any determination of an electronic address for a consumables supplier appropriate to the geographical area as claimed. Fig. 3 of Ohtani merely discloses that the *addresses are inputted with absolutely no association with a geographical area.* The Office has failed to provide any clarification regarding the deficiencies of Ohtani or explanation as to how the teachings of Fig. 3 or elsewhere in Ohtani are to be construed as determining an address for a supplier appropriate to the geographical area. The failure of the Office to identify teachings of Ohtani with respect to the claimed determining of the electronic address in combination with the statement on page 4 of the Action and the failure of Ohtani to refer to a geographical area illustrates the deficiency of the prior art with respect to disclosing or suggesting positively-recited limitations of claim 1.

Referring to the teachings of Sekizawa, it is stated on page 4 of the Action that such reference discloses the geographical area within which the hard copy output engine is to be deployed. Initially, Applicants assert that claim 1 claims

determining of the geographical area, not the geographical area itself as asserted in the Action as being allegedly taught by Sekizawa. Accordingly, even if Sekizawa discloses "the geographical area" as alleged, such teaching fails to disclose or suggest the claimed determining of the geographical area as claimed.

In addition, Sekizawa is directed towards a system and method for monitoring a plurality of network printers connected via a computer network. Col. 18, line 45 - col. 19, line 35, make clear that different areas are provided corresponding to 2a-2c as shown in Fig. 1 and such represent a customer store, business department, or the like. The arrangement includes plural agent units 10 in respective areas 2a-2c and a console unit 20 corresponds to an agency for selling printers or manufacturer of printers. Agent units 10 get status information including information regarding consumables of printers within the respective areas 2a-2c. As set forth in col. 19, lines 27 + the agent unit 10 adds the address of the console unit 20 to the status mail and sends the status mail to mail server 19 and unit 20 thereafter accesses the status mail from the server 19.

There is absolutely no need to determine the geographical area in view of the Sekizawa teachings and Sekizawa is devoid of the claimed determining. More specifically, the arrangement of Sekizawa already provides a system including the console unit 20 for receiving status regarding consumables. The printers provided within a respective area 2a-2c are associated with a respective agent 10 which is configured to communicate the status information to console unit 20. Agents 10 address the status communications for communication to console 20. Accordingly, there is no need to determine the geographical area as claimed since the agent 10 already has its respective address of the unit 20. Regardless of which area 2a-2c the printer is used in, the associated agent 10 is already arranged to communicate with the console unit 20 and there is no teaching that communication to console unit 20 discloses determining of a geographical area as claimed. The recited teachings identified in the office action are devoid of the claimed determining the geographical area inasmuch as the respective agent 10 already has the address of the console 20 which thereafter may process the communications. The interpretation of Sekizawa in the Office Action is directly contrary to the explicit reference teachings. The determining the geographical area of claim 1 is not taught nor suggested by the prior art. Even if the references are combined, the

combination fails to disclose or suggest limitations of claim 1 and claim 1 is allowable for at least this reason.

In the event that a rejection of the claim 1 is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 1 is not found to be allowable.

There is no motivation to combine the reference teachings of Sekizawa with the teachings of Ohtani in support of the 103 rejection and the 103 rejection of claim 1 is improper for at least this additional reason.

On page 4 of the Action it is stated that the combination is appropriate so an operator can easily determine the area in which the machine requires a supply or maintenance and can efficiently deliver the supply. Applicants submit the presented motivational rationale is deficient and non-sensical in view of the Ohtani teachings.

At col. 6, lines 9-34 of Ohtani, it is stated that an email is sent to the official in charge of the fax in the form of Fig. 6. If paper is needed to be ordered, the official fills out the form including the name of the person in charge. Accordingly, Ohtani already provides specific reference teachings for facilitating reordering of paper directed to the person in charge. There is no evidence of record that Ohtani is deficient with respect to consumables ordering or that supply delivery would be made more efficient by using the unrelated different process of Sekizawa which utilizes agents 10 and consoles 20 and does not provide for the interaction of the official of Ohtani. Referring to col. 1, lines 57-65, it is clear that Sekizawa is not directed to a system of Ohtani enabling input/decision-making of the official.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002) stating that the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence. There is no evidence to support the Examiner's motivational rationale and the 103 rejection is improper for at least this reason.

The disparate teachings of Sekizawa regarding agents and consoles are inapplicable to the system of Ohtani utilizing an official to receive emails, check supplies and implement reordering of paper. The bald cursory motivational rationale of efficiently delivering supply is not supported by evidence but is based upon subjective belief of the Examiner and unknown authority. The above-authority makes clear that such is insufficient for a proper 103 rejection and the 103 rejection of claim 1 is improper for this additional reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 4 recites programming the memory with product descriptors for consumable supplies associated with the engine. The teachings of cols. 2-3 of Ohtani identified on page 5 of the Action fail to disclose or suggest any *product descriptors* as claimed. As shown in Fig. 6, the email generated by the fax does not include product descriptors as claimed but rather *the official receiving the email* can indicate the size and number and forward the email to a supply entity for

ordering. Limitations of claim 4 are not shown nor suggested and claim 4 is allowable for at least this reason.

Referring to claim 24, it is stated on page 11 of the Action that Ohtani fails to disclose or suggest that the determining and programming are preformed prior to deployment. The Office fails to recite any authority in support of the bald proposition that claim 24 "does not patentably distinguish the claimed system because it imparts no structural or functional specificity." Claim 24 is directed towards a method. Applicants have positively recited a method step which is admittedly not shown nor suggested by the prior art. It specifically recites temporal limitations which have not been demonstrated by the Office to be incapable of patentably distinguishing the prior art and the Office has identified absolutely no authority in support of its bald statements on page 11. The claimed method in one aspect may facilitate the usage by customers of Applicants' products inasmuch as the products may be programmed prior to purchase, for example, at the factory which clearly offers a utilitarian advantage. The Office's disregard of limitations of claim 24 is not based upon any authority and none has been cited. The Office has failed to present a proper *prima facie* 103 rejection of claim 24 and the statements regarding Applicants' failure to establish that the method is critical is irrelevant in view of the Office's failure to meet their burden of establishing a *prima facie* case of obviousness which is the *initial burden of the Examiner* as set forth by MPEP 2142. Further, the alleged motivational rationale of "the subjective interpretation of the particular way to determine and program does not patentably distinguish the claimed invention" is clearly based upon subjective belief of the Examiner or unknown authority and is not supported by reference teachings or the MPEP.

The art is devoid of disclosing numerous limitations of Applicants' claim 24. The only source of the rejections may result from the personal knowledge of the Examiner. Applicants hereby request identification of prior art which discloses claimed limitations not found in the references of record or the submission of an affidavit in support of any rejection of the claims in *a non-final Action*. "[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA

1970).

Applicants also traverse any interpretation of Ohtani that such reference may be modified to obviate claim 24. In particular, Ohtani is clearly directed towards intervention of an official to check supply and place an order if appropriate. Accordingly, in Ohtani, the determinings and programming can only occur (if at all) once the fax is deployed and the identity of the official is known. Any modification of Ohtani to arrive at the subject matter to claim 24 is contrary to the teachings of Ohtani using the official. For example, at a minimum, step 103 of Fig. 3 of Ohtani may not be performed until deployment. Claim 24 is allowable.

Referring to claim 8, it is recited that the initiating comprises *directly initiating communication with the vendor from the hard copy output engine*. Referring to Ohtani, emails formulated by the fax device are always forwarded to an official as set forth in cols. 5-7 who then checks inventory and places an order if appropriate. The intervention of the official responsible for the fax not only fails to teach or suggest the claimed direct initiation of the communication with the vendor from the engine but teaches away from the Examiner's 103 rejection. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988). Accordingly, even if the references are combined, the combination fails to disclose or suggest limitations of claim 8. In addition, there is no motivation to combine the reference teachings and the rejection of claim 8 is improper for this additional reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Claim 11 recites initiating communication including *transmitting an electronic message from the engine which orders a predetermined quantity of the consumable*. As is clear from Fig. 6 of Ohtani, no predetermined quantity is provided in the email from the fax but input of the official is used in Ohtani to check supply and order an amount if appropriate by filing in "number" on the email of Fig. 6 and placing the order. The proposed modification of Ohtani using Sekizawa set forth on page 6 of the Action is contrary to the teachings of Ohtani using the official to place the order. Claim 11 is allowable for at least this reason.

Referring to claim 15, positively-recited limitations are not shown nor suggested and claim 15 is allowable for at least this reason. Ohtani discloses the fax initiates communication with the official who places an order if appropriate. Ohtani fails to disclose or suggest the claimed processing circuitry which is configured to determine that the consumable is less than a threshold amount, extract an address from memory *and also initiate communication with the supplier using the electronic address*. Ohtani clearly discloses usage of an official to place the orders for the consumable. Accordingly, in no fair interpretation may the processing circuitry of the fax configured to communicate the email of Fig. 6 using an extracted address be considered to initiate communication with the supplier in view of the express teachings of Ohtani regarding the official initiating the ordering of the consumable by re-forwarding the email of Fig. 6 to a supplier if appropriate. Also, there is no motivation to modify Ohtani to provide the fax device with the ability to initiate communication with the supplier in view of the express teachings regarding intervention of the official. Positively-recited limitations of claim 15 are not shown nor suggested by the prior art and there is no motivation to modify the teachings of Ohtani to arrive at Applicants' claim 15. Claim 15 is allowable for at least these reasons:

The claims which depend from independent claim 15 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 22, Ohtani's fax device configured to notify the official using the email of Fig. 6 fails to disclose or suggest the claimed *processing circuitry of the hard copy output engine configured to initiate communication with the supplier* as claimed. Limitations of claim 22 are not shown nor suggested by the prior art and claim 22 is allowable for at least this reason.

Referring to claim 23, as discussed above, the prior art, even if combined, fails to disclose or suggest the claimed determining of the geographical area or the determining of the electronic address. Claim 23 is allowable for at least this reason. Further, there is no motivation to combine the reference teachings and claim 23 is allowable for this additional reason. In addition, the intervention of the official as clearly disclosed in Ohtani fails to disclose or suggest the claimed *proactively*

initiating communication with the consumables supplier from the engine as claimed.
Claim 23 is allowable for these numerous reasons.

Support for the new claims are provided at least at Figs. 1-3 and the associated specification teachings of the originally-filed application including pages 3-6.

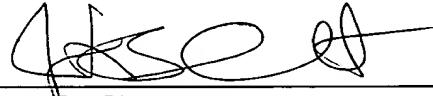
Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Mark A. Harper
Robert E. Haines

By:



James D. Shaurette

Reg. No. 39,833

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